

### **REMARKS**

Claims 1-17 are pending in the application. Claim 17 is withdrawn from consideration. Claims 1-16 have been rejected. New claims 18-21 are added in this paper. Reexamination and reconsideration of the rejections are respectfully requested. A Request for Continued Examination (RCE) is hereby made. A two month extension of time to respond is also hereby requested, and the fee is being paid concurrently herewith.

#### **Summary of Rejections in the Office Action of August 4, 2008**

The Office action of August 4, 2008 rejects claims 1-16 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Specifically, the Office action indicates the word "impermeable" is not explicitly recited in the specification.

The Office action also rejects claims 1-16 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,910,129 to Koblish et al. in view of U.S. Patent 5,680,860.

As explained below, these rejections do not apply to the amended claims that are submitted herein. Withdrawal of the rejections is respectfully requested.

#### **Rejections Under 35 U.S.C. §112**

The word "impermeable" no longer appears in the claims. Consequently withdrawal of the rejections under 35 U.S.C. §112 is respectfully requested.

#### **Rejections Under 35 U.S.C. §103**

The claims as amended relate to embodiments of an apparatus and a related method in which a lever is provided for advancing an ablation element within the housing. Non-limiting examples of such levers are seen, for example, in Figs. 1 and 2 of the present application.

The cited references do not teach or suggest the combination of features as claimed, including the recited lever.

In conjunction with the rejections under 35 U.S.C. §103, it is noted that the Board has consistently held in the post-*KSR* era that an obviousness rejection is not appropriate when there is no evidence or suggestion of a claimed configuration. *Ex Parte Katoh et al*, Appeal 20071460, Decided May 29, 2007. Also, there must be a sufficient and explicit analysis of why the

disclosures of the references should be combined. *Ex Parte Erkey et al*, Appeal 20071375, Decided May 11, 2007.

Furthermore, a sufficient rationale for drawing a conclusion of obviousness must be stated. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (*In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) cited with approval in *KSR*).

Withdrawal of the obviousness rejections is respectfully requested.

### **New Claims 18-21**

New claims 18, 19 and 21 relate to embodiments illustrated in, for example, that shown in Fig. 5. This embodiment has multiple positions at which the ablation element may be positioned. So, for example, a doctor may perform a sequential ablation, in which an ablation element is first moved to a first position at which ablation is performed, then advanced to a second position at which ablation is again performed.

New claim 20 relates to a method utilizing an ablation apparatus having a lever that is operated in order to advance the ablation element.

The combinations of features recited in the new claims are not taught or suggested in the cited prior art. Allowance of these new claims is respectfully requested.

### **Request for Continued Examination**

Request for Continued Examination (RCE) is hereby made. Payment is made at the same time this paper is filed with the Patent Office.

### **Request for Extension of Time to Respond**

Petition for a two-month extension of time in which to respond to the Office action of August 8, 2008 is hereby made. Payment of the fee therefore is made at the same time this paper is filed with the Patent Office.

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**Conclusion and Deposit Account Authorization**

If the Examiner believes that a telephone conference will further the prosecution of this case, the Examiner is kindly invited to contact the undersigned at the number below.

If an appropriate payment does not accompany or precede this submission, the Commissioner is hereby authorized to charge any required fees, such as under 37 C.F.R. §§ 1.16 or 1.17, including any petition for extension of time, or to credit any overpayment, to Deposit Account No. 50-1225 (CFI-5755CON1).

Dated: December 19, 2008



\_\_\_\_\_  
Gregory J. Carlin  
Registration No. 45,607  
Edwards Lifesciences LLC  
One Edwards Way  
Irvine, California 92614  
Telephone: (949) 250\_6893  
Facsimile: (949) 250\_6850